

08 MAR 2000



UNITED STATES DEPARTMENT OF COMMERCE
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Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Ronald Craig Fish
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In re Application of :
FUHRMANN et al. :
Serial No.: 09/214,158 : DECISION
PCT No.: PCT/US97/03984 :
Int. Filing Date: 12 March 1997 :
Priority Date: 14 March 1996 :
Atty. Docket No.: TER-004.2P :
For: DATA TRANSMISSION USING ATM
OVER HYBRID FIBER COAX

This is a response to the petition under 37 CFR 1.47(a) filed 12 August 1999 to accept the application without the signature of joint inventor, Amir Fuhrmann. The fee under 37 CFR 1.17(i) for the petition under 37 CFR 1.47(a) has been submitted.

BACKGROUND

On 12 March 1997, applicants filed international application PCT/US97/03984, which claimed a priority date of 14 March 1996 and which designated the United States. A Demand for international preliminary examination electing the United States was not filed prior to the expiration of 19 months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 14 November 1997.

The application was **ABANDONED** on 15 November 1997 for failure to pay the basic national fee 20 month from the priority date.

On 23 December 1998, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee, the surcharge under 37 CFR 1.492(e), and a declaration signed by Selim Shlomo Rakib and Yehuda Azenkot.

On 03 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 12 August 1999, applicant filed a petition under 37 CFR 1.47(a) and the requisite fee and a declaration of Ronald Craig in support of petition under 37 CFR 1.47.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite \$130 petition fee required by 37 CFR 1.17(i); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Items 1, 3, and 4 above have been satisfied.

Regarding item 2 above, a review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Mr. Fuhrmann. The declarations of Mr. Fish did not indicate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor(s) for signature as required. As stated in Mr. Fish's declaration, "[a] declaration for Patent Application was drafted which, on or about December 17, 1998, was sent to Mr. Fuhrmann at his last known address...." The mailing of the Declaration is not considered a complete copy of the application paper (specification, including claims, drawings, and oath and declaration). No documentary evidence to support the refusal or the attempt was provided in Mr. Fish's declaration. Furthermore, it does not appear that Mr. Fish has first hand knowledge of all the facts.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Mr. Fuhrmann and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the above reasons, it would not be appropriate to accept this application without the signature of Mr. Fuhrmann at this time.

RECOMMENDATION

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. See 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Effective Date: 01 December 1997).

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay, (2) a proper reply, (3) the petition fee required by law and (4) a terminal disclaimer and fee in all applications filed before 08 June 1995.

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be accompanied by: (1) a proper reply; (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition fee required by law is \$1210.00 for a non-small entity.

The filing of any petition under the unintentional standard cannot be intentionally delayed. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay was unintentional. A statement that the delay was unintentional is not appropriate if the petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137: (1) the delay in the reply that originally resulted in the abandonment; (2) the delay in filing an initial petition under 37 CFR 1.137 to revive the application; and (3) the delay in filing a grantable petition under 37 CFR 1.137 to revive the application. See 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997).

In the instant case, the required response has already been filed.

See Section 711.03(c) of the Manual of Patent Examining Procedure (MPEP). Also note the changes to patent practice and procedure at 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Effective Date: 01 December 1997).

This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

CONCLUSION

Accordingly, this application remains **abandoned**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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